

Applicants: Crone

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Title: System and Method of Improving Customer Health, Reducing Income Tax by Charitable Gift, and Providing Hunger Relief for the Needy

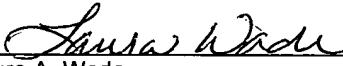
Examiner: Mr. Florian M. Zeender

Group Art Unit: 3627

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Laura A. Wade

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is Mr. James C. Crone.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Applicant's knowledge.

(3) STATUS OF CLAIMS

Claims 1-20 are pending in the application. The Examiner has rejected all pending claims. Accordingly, Applicant appeals the rejection of claims 1-20.

(4) STATUS OF AMENDMENTS

All amendments have been entered.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

All claims relate to a method of doing business – in particular, a method of conducting a sales transaction between a restaurant and a customer that improves the customer's health and facilitates charitable giving by the customer. Claim 1 recites selling a reduced-portion meal product to a customer at the price of a corresponding full-portion meal product. As discussed at p. 4, lines 14-21, the reduced-portion meal is in contrast to the current trend of most fast food restaurants selling a “super-size” meal. More specifically, a reduced-portion meal product is defined at p. 4, line 22 – p. 4, line 4, as comprising the same elements as a corresponding full-portion meal product, but in reduced quantities. The reduced quantities of meal elements (e.g., burger, fries, and the like) contribute directly to the customer's health by reducing his caloric and fat intake. See generally, p. 1, lines 8-24, and in particular, p. 2, lines 1-12.

According to claim 1, the restaurant collects at least the price of a full-portion meal product in funds from the customer. The funds comprise two parts – a base amount corresponding to the cost for the restaurant to prepare and sell the reduced-portion meal product and an excess amount. The excess amount is the difference between the base amount and the sale price. p. 5, lines 4-8.

Why would any customer pay a full-portion meal price for a reduced-portion meal product? According to the inventive business method of claim 1, the restaurant turns the excess amount paid into a charitable donation on behalf of the customer by transferring at least part of the excess amount to a charity. p. 5, lines 9-20.

Claim 3 recites augmenting this business method by transferring additional funds to the charity in an amount directed by the customer. For example, the customer “round-up” his change to the next dollar, and direct that the difference be added to his charitable

donation. p. 5, line 21-25. As recited in claim 5, the customer may select a particular charity at the time of the sale. p. 6, lines 8-10. Claims 7-10 recite providing the customer with a unique indicator (e.g., "affinity card") he can use each time he purchases a reduced-portion meal product. p. 7, line 26 – p. 8, line 24. This allows the customer's charitable contributions to be tracked over time, the restaurant may send him a summary as documentation of the contributions, to claim a tax deduction. p. 6, lines 12-17.

Claim 11 is directed to a system for facilitating charitable donations by a restaurant customer. The system includes a point of sale station operative to process and record the sale of at least a reduced-portion meal product at the price of a corresponding full-portion meal product. p. 5, line 26 – p. 6, line 8. The system also includes a database operative to record the reduced-portion meal product transaction, including funds received pursuant to said reduced-portion meal product transaction. p. 6, lines 18-25. The system further includes a financial transaction processor operative to transfer funds to a charitable organization on behalf of the customer purchasing the reduced-portion meal product. p. 7, lines 5-16. Claims 12-20 recite various specific embodiments of the system of claim 11.

(6) GROUNDS OF REJECTION

Claims 1-7 and 9-11 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1-6, 11-14, and 19-20 are rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,724,518 to Helbling ("Helbling").

Claim 7-10 and 15-18 are under 35 U.S.C. §103 as being unpatentable over Helbling in view of U.S. Patent No. 6,088,682 to Burke ("Burke").

(7) ARGUMENT RELATING TO THE § 101 GROUND OF REJECTION

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 101. The Supreme Court has construed § 101 broadly, noting an intent by Congress to "include anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). The Court has excluded from §101 subject matter only "laws of nature, natural phenomena, and abstract ideas." *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

A. An Abstract Idea

The Examiner maintains that claim 1 is directed to non-statutory subject matter, comprising only an "abstract idea." The Examiner asserted:

In the present case, claims 1-7 and 9- 10 only recite an abstract idea. The recited steps of merely selling a meal, collecting a price, and transferring an amount, do not necessarily apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to facilitate charitable contributions.

Final Office Action, p. 2, fourth paragraph. All three assertions are incorrect.

First, claim 1 does not recite an abstract idea. Claim 1 recites the method steps of selling a meal product at a specific price, collecting at least that price in funds, and transferring part of those funds to a charity. As well known in the art, selling a meal and collecting funds for the sale constitute a commercial transaction. A commercial transaction is a trade of valuable goods or services for money or a money substitute (e.g., credit card transaction, check or other commercial paper, or the like). Claim 1 does not recite "contemplating a sale" or even "negotiating a sale price," which may arguably be characterized as "abstract ideas." Rather, claim 1 explicitly recites selling a meal product, and collecting funds. Neither is an abstract idea; both are concrete

actions. Furthermore, transferring funds to a charity cannot be accurately characterized as an “abstract idea” – certainly, no charity designated to receive the funds would think so! Transferring funds from one party to another is a concrete action, resulting in the transfer of legal title to money or a money substitute from one entity to the other. There is nothing abstract about it.

Second, it is absolutely false that “all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.” Both a meal product and funds (at least in the form of cash) are concrete, tangible items. A person can think about selling one and collecting the other all day, but he cannot accomplish an actual sale and collection of funds in his mind; that requires a product and money or money substitute. Nor can one transfer funds to a charity by merely thinking about it. No limitation recited in claim 1 can be “performed in the mind of the user.” The transfer of funds to a charity may possibly be performed “by use of a pencil and paper” – but only if the pencil is a pen and the paper is a check or the signature authorization of an electronic funds transfer. Selling a meal product cannot be performed by use of a pencil and paper – it requires the physical transfer of a meal product from a restaurant to a customer, in exchange for an amount of funds.

Finally, the Examiner erred in asserting, “these steps only constitute an idea of how to facilitate charitable contributions.” In fact, when performed, these steps – selling a meal product, collecting funds for it, and transferring part of the funds to a charity – accomplish the charitable contribution. Following actions – not abstract ideas – that meet all the limitations of claim 1, a customer has a reduced-portion meal product to eat, the restaurant has collected its price for the meal product (and supposedly made a profit), and a charity has more funds in its coffers than it had before the customer entered the restaurant. This status cannot be achieved by “only” an idea; it requires actively executing the method steps recited in claim 1.

As none of the facts averred by the Examiner in support of the conclusion that claim 1 recites only an abstract idea, such a conclusion cannot stand.

B. The Technological Arts

The stated basis for the § 101 rejection is that claim 1 is not directed to “the technological arts.” Final Office Action, p. 2, second paragraph. In the Response to the First Office Action of December 20, 2004, Applicant noted, “The Examiner provided a two-part test for determining patentability, without citation to the MPEP or any controlling legal authority. Furthermore, the Examiner provided no definition of ‘technological arts.’” Both facts remain true; the Examiner has merely repeated the two-part test, *Id.*, and has failed to provide any legal authority to support it. Furthermore, the Examiner has failed to define the “technological arts,” other than to provide a non-limiting example of what it does not encompass, *i.e.*, the social sciences. Final Office Action, p. 2, third paragraph.

In “Response to Arguments” in the Final Office Action, the Examiner offered only a circular definition of the imposed requirement that the invention be within the technological arts: “The invention in the body of the claims must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory.” p. 2, third paragraph. As authority for this alleged requirement of patentability, the Examiner cited to *Ex Parte Bowman*, 61 USPQ2d 1669, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished). *Bowman* is an unpublished opinion, and is not binding precedent of the Board. *Bowman*, Editor’s Note at 1670. The case has no precedential value, and does not stand for the proposition of imposing any requirement of patentability.

The invention at issue in *Bowman* was the analysis of performance criteria related to two variables, scoring the criteria and summing the scores, plotting a point on a chart reflecting the total scores, and using the chart to make a decision. In stark contrast to the present invention, the invention of *Bowman* could literally be performed

“by use of a pencil and paper.”¹ As discussed above, the present invention is readily distinguished from *Bowman* by the impossibility of meeting every limitation of claim 1 by mental exercise, or by mere use of a pencil and paper. Claim 1 recites conducting a commercial transaction that requires selling a product and collecting funds therefor, and further recites the transfer of part of those funds to a charity.

The Board in *Bowman* equated “technological arts” with the Constitutional term “useful arts.” *Accord, Application of Bergy*, 596 F.2d 952, 959 (Cust. & Pat.App. 1979) (“[T]he present day equivalent of the term ‘useful arts’ employed by the Founding Fathers is ‘technological arts.’”), *In re Waldbaum*, 457 F.2d 997 (Cust. & Pat.App 1972). That methods of doing business fall within the “useful arts” is beyond question. *State Street Bank & Trust Co. v. Signature Fin. Group Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998) (“We take this opportunity to lay this ill-conceived [business method] exception to rest.”). *State Street* considered a “hub and spoke” method of accounting for mutual funds within a partnership. While the claim at issue in *State Street* was directed to an apparatus that performed the hub and spoke accounting, the Federal Circuit stated, “We note that, for the purposes of a § 101 analysis, it is of little relevance whether claim 1 is directed to a “machine” or a “process,” as long as it falls within at least one of the four enumerated categories of patentable subject matter, “machine” and “process” being such categories.” *Id.*, at 1372. See also, *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1357 (Fed. Cir. 1999) (“Whether stated implicitly or explicitly, we consider the scope of § 101 to be the same regardless of the form--machine or process--in which a particular claim is drafted.”).

Claim 1 unquestionably recites a method of doing business. In particular, it recites a method of selling a reduced-portion meal product at the price of a full-portion

¹ Indeed, Judge Dixon noted that plotting a point on a chart “may be as broad as using a stick in the sand or dirt.” *Bowman*, at 1674 (Dixon, J., concurring).

meal product, collecting at least that price in funds from a customer, and transferring part of the excess amount of the funds to a charity on the customer's behalf. Those of skill in the art will readily recognize that the method of claim 1 may be implemented by use of a computerized point of sale terminal, database, and transactional processor (as described in the Specification at p. 5, line 26; p. 6, line 8; p. 6, lines 18-25; p. 7, lines 5-16). Similarly, the patentable "hub and spoke" business method claim at issue in *State Street* could be performed with a pencil and paper. As the Federal Circuit has made clear, whether the claim is cast as a method or apparatus is irrelevant to a § 101 analysis.

A long line of Federal Circuit and Supreme Court patent cases have evolved away from the antiquated idea that any invention that includes a computer calculating an algorithm is unpatentable subject matter because a mathematical algorithm is an "abstract idea." See, e.g., *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), *Diamond v. Diehr*, 450 U.S. 175 (1981), *Parker v. Flook*, 437 U.S. 584 (1978); *Gottschalk v. Benson*, 409 U.S. 63 (1972). The Examiner's rejection of claim 1 and the underlying rationale extend this evolution of the case law to the untenable conclusion that the recitation of some computational gadget or gizmo is now required to satisfy the statutory subject matter requirement of § 101. This position lacks support in the patent law.

Even under the mathematical algorithm cases, a claimed method recites patentable subject matter if it produces a useful result, even if the method includes an algorithm. The Examiner has admitted that claim 1 has utility and produces a useful result. Claim 1 thus recites statutory subject matter under § 101, and the Examiner's rejection of claims 1-7 and 8-10 must be reversed.

C. No Legal Basis for the Rejection

As noted above, the only legal precedent cited by the Examiner in support of the § 101 rejection is *Bowman*, an unpublished, nonprecedential opinion of the Board. The Examiner additionally cited to MPEP § 2106 IV 2(b) (sic), quoting language that appears to discuss *Bowman* as if it had any legal precedential value. Section 2106 IV B 2(b) of the Eighth Edition of the MPEP (August 2001, Last Revision May 2004) does not mention *Bowman* at all. Indeed, *Bowman* is not listed in Appendix II, List of Decisions Cited, and hence is not cited as controlling authority on any point, anywhere in the entire MPEP.

Section 2106 discusses patentable subject matter with respect to computer-related inventions. Claim 1 does not recite a computer or that any recited method step must be performed by a computer (indeed, the lack of a computer in claim 1 appears to be the crux of the Examiner's "technological arts" rejection). MPEP § 2106 IV B 2(b) states, "To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan ..." Claim 1 is not a computer-related process; hence MPEP § 2106 IV B 2(b) is wholly inapposite.

However, Applicant notes, *arguendo*, that the method of claim 1 unquestionably "result[s] in a physical transformation outside the computer [the transfer of title of a reduced-portion meal product, the collection of funds for the meal product; and the transfer of funds to a charity] for which a practical application in the technological arts is ... disclosed in the specification." See p. 5, line 26 – p. 7, line 25, discussing a practical application of claim 1 that includes point of sale terminals communicatively coupled to one or more databases and a financial transaction processor. Thus, if MPEP § 2106 IV

B 2(b) had any applicability to claim 1, it would indicate that claim 1 recites statutory subject matter.

(8) ARGUMENT RELATING TO THE § 103 GROUND OF REJECTION OVER HELBLING

Helbling discloses a method of inducing a customer to make a charitable donation by providing him with a free beverage as a reward for the donation. The free beverage is provided at the restaurant's expense. Helbling teaches that the entire donation is transmitted to a charity.

A. Helbling Does Not Teach or Suggest Full- or Reduced-Portion Meal Products

In rejecting claims 1 and 11, the Examiner constructed a purely hypothetical "full-portion meal" including a beverage – which Helbling does not teach or suggest – and asserted that Helbling discloses selling a "reduced-portion meal" that does not include a beverage – which also finds no support in the disclosure of Helbling. This tortured construction of Helbling can be arrived at only through the teaching of claims 1 and 11, using impermissible hindsight. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg., Inc. v. SGS Importers Intern., Inc.*, 73 F.3d 1085, 1087 (Fed. Cir. 1995).

Helbling discloses simply offering a customer a free beverage if the customer makes a charitable donation. Helbling does not suggest or disclose preparing a reduced-portion meal product, selling it for the price of a corresponding full-portion meal product, and transferring part of the excess funds to a charity. That teaching comes only from Applicant's claims. This is improper obviousness analysis, as a matter of law.

B. Helbling Does Not Teach or Suggest Selling a Reduced-Portion Meal at the Price of a Corresponding Full-Portion Meal, There Is No Motivation to Modify Helbling To Do So, and Helbling Teaches Away From Doing So.

The Examiner admitted (assuming *arguendo* that Helbling can be construed to suggest the Examiner's purely hypothetical full- and reduced-portion meal products) that Helbling does not teach or suggest the price of the reduced-portion meal being the price of a corresponding full-portion meal. The Examiner stated it would be obvious for Helbling to impose a minimum donation amount equal to the beverage price. Not only is there no motivation modifying Helbling in this manner – Helbling explicitly teaches against it.

In operation of the system, a prospective donor, generally also a patron of the fastfood establishment, selects the food items offered by the cashier at the register 10 who punches in the food items, registering the charges. The patron is offered the opportunity to make a certain minimum donation to a particular charity, e.g. **twenty-five cents**, and if the donor is willing, the amount of the contribution, including any additional amount the donor may choose, is punched into the cash register by the cashier and appears on the display 12. . . . [A] slip 24 is printed with a receipt for the contribution and information as to the magnitude thereof as well as information as to the number of beverages to be dispensed as the reward by the service establishment for the contribution level made.

Helbling, col. 4, lines 23-46 (emphasis added). Even in 1996, the filing date of the Helbling application, the price of a beverage in a fast food restaurant far exceeded twenty-five cents. By suggesting a minimum donation level of a quarter, Helbling teaches that which is known to those of skill in the art – that the minimum donation must be a token amount, as compared to the price of the reward, to encourage participation. Making the minimum donation amount equal to the price of the beverage, as the Examiner suggested, would discourage rather than encourage participation. As well known in retailing, if a customer does not perceive he is getting something “free,” or at the very least at a substantial discount, he will not participate in a promotion.

The Examiner's assertion, in Response to Arguments in the Final Office Action, that the customer would get the beverage "free" by not actually paying the restaurant, is nonsensical. The beverage is not free to the customer if the customer pays precisely the same amount for it. The Examiner further asserted that the customer would be able to benefit financially due to a tax "write-off" for the donation. However, this benefit accrues with any charitable donation at all, and provides no motivation to one of skill in the art to modify Helbling by elevating the disclosed token \$0.25 minimum donation to any substantial amount, much less the full cost of a beverage (a particular price point taught only by Applicant's claims 1 and 11).

Increasing the minimum donation will reduce participation, up to the point of setting it at the price of the beverage, which will minimize participation (going beyond that point will effectively terminate participation). The purpose of Helbling is to maximize participation. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). MPEP § 2143.01.

B. Helbling Does Not Teach or Suggest Transferring Only Part of a Customer's Donation to a Charity, There Is No Motivation to Modify Helbling To Do So, and Helbling Teaches Away From Doing So.

The Examiner also admitted (again, adopting only *arguendo* the Examiner's tortured logic that the free beverage of Helbling creates full- and reduced-portion meals absent the teaching of Applicant's claims) that Helbling does not teach or suggest that only part of the customer's charitable donation (the excess amount of funds, as recited in claim 1) is transferred to the charity. The Examiner stated, "it is well known in business for a company to receive a processing/handling/operating fee for work performed." Yet

here again, Helbling itself teaches away from the Examiner's bald assertion of what would have been an obvious modification of the reference. A prior art reference must be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986).

At its core, Helbling relies on the generosity of the restaurant in providing a free beverage to customers willing to make a charitable donation. “[T]he establishment awarding the patron a free beverage...” col. 2, lines 5-12. “The patron, in consideration of the charitable contribution made, is in turn awarded a token...” col. 2, lines 60-61. “[T]he number of beverages to be dispensed as the reward by the service establishment for the contribution level made.” col. 4, lines 44-46. “Thus any patron availing him or himself of the opportunity to make a contribution, not only can benefit from the free food service item...” col. 5, lines 8-10. “[P]atrons benefit from the largess of the food-service establishment in making beverages available free of charge to contributors.” col. 5, lines 37-39.

Taken as a whole, as the Examiner is required to do, it is clear that the entire Helbling system relies on the restaurant's largess, both in offering free beverages to customers as an inducement, and in operating the system by which customer charitable donations are tracked and transferred to the charities. With the low minimum donation amount Helbling suggests – \$0.25 – it is improbable that the restaurant would retain a processing fee from the donation, particularly considering that the restaurant is providing the beverages free of charge! As a “useful general rule,” a prior art reference that teaches away from the invention cannot serve to create a *prima facie* case of obviousness. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

The only motivation provided by the Examiner for modifying Helbling to retain part of the charitable donation is that “it is well known in business for a company to

receive a processing/handling/operating fee for work performed.” However, the mere fact that some businesses charge a fee for work performed – or that it would be possible for a restaurant in Helbling to do so – provides absolutely no motivation making the proposed modification. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Here, Helbling not only fails to suggest the desirability of the modification, it strongly teaches away from it, by express reliance on the “largess of the food-service establishment.” col. 5, lines 37-39. Nor has the Examiner provided any motivation in the art generally for the motivation, noting only that it is known for some other businesses to do so. This is legally insufficient motivation for one of skill in the art to modify Helbling to do so. Thus, the rejection of claims 1, 4, 11, and 20 cannot stand.

C. Helbling Teaches Away From Claim 1

In addition to teaching away from the retention of part of a customer’s donation by the restaurant, as recited in claim 1, Helbling as a whole teaches away from the very structure and system of the present invention. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *Gurley*. The “path” taught by Helbling is to rely on the philanthropic nature of restaurant owners, both to implement and operate the charitable donation collection system, and in particular to provide the incentive to donate by supplying a free beverage, at the restaurant’s expense. A fair reading of Helbling makes it clear that the system simply would not be functional without the restaurant’s donation of the beverage. “[P]atrons benefit from the largess of the food-service

establishment in making beverages available free of charge to contributors." col. 5, lines 37-39.

In contrast, the "path" followed by the Applicant is to appeal to the philanthropic nature of the customer, and to provide an incentive that is in the customer's own self-interest: his health. Claim 1 recites "a method of improving customer health and facilitating charitable giving." Both are motivations for the customer to chose a reduced-portion meal product, and donate the difference between it and the corresponding full-portion meal product to a charity.

Additionally, the present invention does not rely on the largess of restaurant owners, but rather operates within the hard, cold reality that restaurants are for-profit enterprises in business to make money. By selling a reduced-portion meal product at the price of a corresponding full-portion meal product, and transferring part of the excess funds to a charity, the restaurant is not required to donate or offer anything free or at a discount. Furthermore, the restaurant may recover the cost of implementing and operating the inventive method and system by retaining a portion of the excess amount of funds collected (those over the cost of preparing and selling the reduced-portion meal product). See p. 5, lines 4-17. This feature may be key to widespread adoption and implementation of the invention in the food service industry, as the restaurants' profits are not affected.

The Examiner dismissed this argument by asserting that the feature is not claimed. This is erroneous. The structure of funds collected by the restaurant for a reduced-portion meal product is clearly and explicitly recited in claim 1. To wit, the funds comprise a base amount corresponding to the reduced-portion meal product and an excess amount. Furthermore, claims 1 recites that part of the excess amount is transferred to a charity. In the context of allocating funds collected in the sale of a product, those of skill in the art would interpret a "base amount corresponding to the

product sold" to mean an amount that covers at least the cost (if not, indeed, cost plus profit) of the product. Similarly, an "excess amount," over and above the base amount corresponding to the product sold, would be interpreted by those of skill in the art to mean an amount that, if retained by the restaurant, would be pure profit (*i.e.*, an "excess amount"). Any other interpretation is unreasonable, and must depart from the plain meaning of the claim terms. MPEP § 2111.01 II.

Claim 1 explicitly recites that only part of the excess amount – not the base amount corresponding to the reduced-portion meal product – is transferred to a charity. Thus, it is inherent in the plain language of claim 1 that a restaurant performing the recited method steps need not donate or contribute anything. This is in stark contrast to the system of Helbling, which expressly relies on the restaurant's donation of a free beverage. Since Helbling would lead a person of ordinary skill in a direction divergent from the path taken by the Applicant – that is, reliance on the philanthropy of a restaurant owner rather than the customer's healthy self-interest – Helbling, considered as a whole, teaches away from the present invention of claim 1, and thus cannot support a *prima facie* case of obviousness.

D. The Examiner's Hypothetical Full- and Reduced-Portion Meal Products do not Meet Those Claim Terms as Explicitly Defined in Applicant's Specification.

It is firmly established in the patent law that a patent applicant may be his own lexicographer by clearly defining claim terms in the specification. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc) *aff'd*, 517 U.S. 370 (1996). Where clearly defined, claim terms must be examined with the meaning Applicant gives them. MPEP § 2111.01(III).

A reduced-portion meal product is clearly defined in Applicant's specification at p. 4, lines 22-24: "Each reduced-portion meal product comprises the same elements as

its corresponding full-portion meal product, but in reduced quantities.” The Examiner’s hypothetical full-portion meal in Helbling, comprising a meal with a beverage, and his hypothetical reduced-portion meal comprising a meal without a beverage (the beverage being provided free by the restaurant) fail to meet the definition of those terms, as explicitly defined. The proposed reduced-portion meal product does not comprise the same elements – e.g., a beverage – as the corresponding full-portion meal product, but in reduced quantities.

In “Response to Arguments” in the Final Office Action, the Examiner dismissed the definition as unclear, citing to p. 5, lines 18-20, and claiming this language makes the definition of a reduced-portion meal product ambiguous. The cited passage in the specification must be read in the context of the example preceding it (the language cited by the Examiner is in italics below):

For example, a reduced-portion meal product comprising half of the food of a corresponding full-portion meal product may sell for a price, of which half is a base amount (the cost of the reduced-portion meal product) and half is an excess amount. The restaurant may retain for example a 10% operating fee, thus donating 40% of the price of the reduced-portion meal product to a charity on the customer’s behalf. *Of course, those of skill in the art will readily recognize that a wide variety of reduced-portion meal product configurations, with concomitant cost and price structures, as well as operating fees, are possible within the broad practice of the present invention.*

Specification, p. 5, lines 13-20. For clarity (to comply with the various requirements of 35 U.S.C. § 112), a specific example is offered in which the quantity of each element of a reduced-portion meal product is one-half that of the corresponding full-portion meal product. In this example, half of the funds collected comprise the base amount recited in claim 1, and half is the excess amount. In this specific example, the restaurant may retain 10% of the funds as an operating fee, and transfer 40% of the funds to a charity. The example is provided for full explication of the invention only, and is not limiting.

To emphasize that the example is non-limiting, the Specification goes on to state that to which the Examiner cited, that a variety of reduced-portion meal product configurations, with concomitant cost structures, is possible. A reduced-portion meal product comprising half the quantity of each element of a corresponding full-portion meal product, as specified in the example, is one possible configuration. Another configuration is that the reduced-portion meal product comprises 80% of each element of a corresponding full-portion meal product. This alternative configuration fully complies with the definition of a reduced-portion meal product at p. 4, lines 22-24. Naturally, this reduced-portion meal product will have a different cost structure – that is, it will cost 80% of the price of the full-portion meal product, not 50%. Thus, in this case, the base amount recited in claim 1 would be 80% of the funds collected from the customer, and the excess amount, 20%.

It is apparent that many different configurations, and concomitant cost structures are possible² – however, this fact in no way renders the definition of a reduced-portion meal product ambiguous or unclear. In each such configuration, a reduced-portion meal product comprises the same elements as its corresponding full-portion meal product, but in reduced quantities, as defined at p. 4, lines 22-24. The claims must be examined with this definition of the term, and under this definition, the Examiner's hypothetical reduced-portion meal product in Helbling, comprising a meal without a beverage (constructed only with the teaching of claims 1 and 11 to begin with), fails to meet this definition. Helbling thus fails to teach or suggest each claimed limitation. Accordingly, the § 103 rejection of claims 1 and 11 over Helbling must be withdrawn.

² That the price of the full-portion meal may vary, e.g., depending on whether it comprises a hamburger and fries, or a steak and potato, has nothing to do with the definition of a reduced-portion meal product. Neither does the fact that the operating fee retained by the restaurant may vary.

(9) ARGUMENT RELATING TO THE § 103 GROUND OF REJECTION OVER HELBLING IN COMBINATION WITH BURKE

Burke teaches a clearinghouse central computer connected to a plurality of point of sale terminals at merchants. Customers may direct that their change from purchases, or other funds, be allocated to charitable or savings accounts. Customers are identified by, e.g., a card with a magnetic stripe.

The Examiner has failed to establish a *prima facie* case of obviousness in rejecting claims 7-10 and 15-18 over Helbling in view of Burke, as no sufficient motivation to combine the references has been provided. Helbling provides a complete and sufficient system for collecting charitable contributions by restaurant patrons, complete with a national/regional office computer 37 communicatively linked to each restaurant computer 21, which collects charitable contributions from all point of sale terminals 10 in a given restaurant. See Figure 1. That is, Helbling discloses a self-sufficient system that does not need and would not benefit from the elaborate network disclosed in Burke.

Furthermore, Helbling, taken as a whole, makes it clear that customers are enticed to contribute to charities by the offer of a free beverage by the restaurant, not any tax deduction. There is no teaching or suggestion that the restaurant customer in Helbling wants his charitable contributions tracked and totaled. In fact, the suggested minimum donation amount of \$0.25 strongly suggests that most customers would not consider the minuscule tax savings to be worth the effort of receiving and processing a statement of their token contributions.

Nor does Burke provide any motivation for modifying the teaching of Helbling. Customers that do not wish to be bothered with their excess change may donate those funds to the charity of their choice by the unmodified system of Helbling. “[I]f the donor is willing, the amount of the contribution, including any additional amount the donor may

choose, is punched into the cash register by the cashier and appears on the display 12." col. 4, lines 28-31. Hence, the functionality of Burke is superfluous.

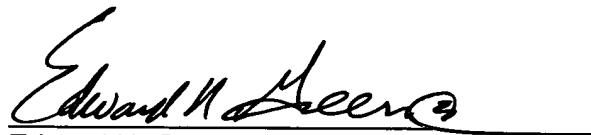
There being no motivation to combine the references, either in the references themselves or in the art, the Examiner has failed to establish a *prima facie* case of obviousness, and the rejection of claims 7-10 and 15-18 must be reversed.

Conclusion

For the reasons set forth above, all claims being appealed herein recite patentable subject matter, and are patentably nonobvious over the cited art. Accordingly, the rejections maintained by the Examiner must be reversed.

Respectfully submitted,

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(10) CLAIMS APPENDIX

1. A method of improving customer health and facilitating charitable giving, by a restaurant, comprising:
 - selling a reduced-portion meal product to a customer at the price of a corresponding full-portion meal product;
 - collecting at least said price in funds from the customer, said funds comprising a base amount corresponding to said reduced-portion meal product and an excess amount; and
 - transferring part of said excess amount to a charity on behalf of the customer.
2. The method of claim 1 wherein said excess amount of said funds includes the difference in cost of said reduced-portion meal product and said corresponding full-portion meal product.
3. The method of claim 1 further comprising transferring additional funds to said charity in an amount directed by the customer.
4. The method of claim 1 wherein the part of said excess amount transferred to the charity comprises said excess amount less an operating fee.
5. The method of claim 1 wherein the customer may select a charity from among a plurality of charities at the time of the sale.

6. The method of claim 1 wherein the customer is provided a receipt at the point of sale memorializing the transaction and indicating the amount of the charitable donation.
7. The method of claim 1 further comprising:
 - upon the customer's initial purchase of said reduced-portion meal product,
 - providing the customer a unique identifier; and
 - upon subsequent purchases, using said unique identifier to identify the customer.
8. The method of claim 7 wherein said unique identifier is encoded on a card including at least one of an identification number, an optical code, a magnetic stripe, an RFID transponder, and an integrated circuit.
9. The method of claim 7 further comprising tracking the customer's charitable donations across multiple sales.
10. The method of claim 9 further comprising providing the customer with a summary of charitable donations over a predefined time period.
11. A system for facilitating charitable donations by a restaurant customer, comprising:
 - a point of sale station operative to process and record the sale of at least a reduced-portion meal product at the price of a corresponding full-portion meal product;
 - a database operative to record said reduced-portion meal product transaction, including funds received pursuant to said reduced-portion meal product transaction; and

a financial transaction processor operative to transfer funds to a charitable organization on behalf of the customer purchasing said reduced-portion meal product.

12. The system of claim 11 wherein said point of sale station includes an output device operative to produce a receipt memorializing the sale of said reduced-portion meal product, and indicating the funds transferred to said charitable organization on the customer's behalf.
13. The system of claim 11 wherein said database is operative to record reduced-portion meal product transactions from a plurality of said point of sale stations.
14. The system of claim 13 wherein said database is operative to record reduced-portion meal product transactions from said point of sale stations located in at least two restaurants.
15. The system of claim 11 wherein said point of sale station includes an input device operative to receive a unique customer identifier.
16. The system of claim 15 wherein said input device includes at least one of a numeric keypad, a microphone and voice recognition software, an optical scanner, a magnetic stripe reader, an RFID transponder reader, and an integrated circuit data interface.

17. The system of claim 15 wherein said database stores, for each customer that provides a unique customer identifier, at least the unique customer identifier and the funds transferred to a charitable organization on behalf of the customer.
18. The system of claim 17 wherein said database is operative to generate a summary of the funds transferred to a charitable organization on behalf of the customer over a predetermined time period.
19. The system of claim 11 wherein funds received pursuant to said reduced-portion meal product transaction include a base amount, an excess amount, and an optional additional amount, wherein the funds transferred to a charitable organization on behalf of the customer comprise a portion of said excess amount and said additional amount.
20. The system of claim 19 wherein the portion of said excess amount transferred to a charitable organization comprises said excess amount less an operating fee.

(11) EVIDENCE APPENDIX

There is no further evidence not contained in the prosecution history.

(12) RELATED PROCEEDINGS APPENDIX

There are no related proceedings.